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10/774,261	02/06/2004	Michael J. Shelton	200209031-1	8670
22879 7590 08/07/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER RODRIGUEZ, LENNIN R				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
08/07/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM

mkraft@hp.com

ipa.mail@hp.com

Office Action Summary

Application No.

10/774,261

Applicant(s)

SHELTON ET AL.

Examiner

LENNIN R. RODRIGUEZ

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-17 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) 18-39 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-8 and 10-17 is/are allowed.
- 6) ☒ Claim(s) 1, 9, 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 14-15, filed on 5/02/2008, with respect to the rejection(s) of claim(s) 1, 9 and 40-42 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kato (US 6,141,111) and Edwards (US 2004/0174562).

Election/Restrictions

2. Claims 2-8 are allowable. The restriction requirement among Species V and Species III, and Species II, as set forth in the Office action mailed on 12/05/2007, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 7-8, directed to a method of printing user-selected ones of a collection of images, comprising storing the print job in a memory and determining a printing cost associated with printing the at least one selected image, and inhibiting the printing if the printing cost exceeds a user-specified maximum cost are no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim. However, claims 18-39, directed to Species I, and IV remain withdrawn from consideration because they do not all require all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1, 9 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) in view of Edwards (US 2004/0174562).

(1) regarding claim 1:

Kato '111 discloses a method of printing user-selected ones of a collection of images, comprising:

printing a plurality of proof sheets (column 5, lines 1-4, where a proof sheets are being printed) each having a thumbnail representation of at least some of the images (column 5, lines 38-41, where the reduced image is being interpreted as a thumbnail image), and at least one user-markable field indicative of at least one corresponding

image when marked (column 5, lines 40-41, where the check portion is the user-markable field);

optically scanning user-marked proof sheet to detect marked ones of the at least one user-markable field (column 6, lines 21-25, where Step S5 is performing the scanning of the proof sheet);

processing the marked ones of the fields to determine at least one selected image associated with each scanned proof sheet (column 6, lines 26-33, where each proof sheet is checked for the markings in the sheet); and

printing the at least one selected image after the user-marked proof sheet has been scanned (column 6, lines 38-45).

Kato '111 discloses all the subject matter as described above except scanning a plurality of user-marked proof sheets.

However, Edwards '562 teaches scanning a plurality of user-marked proof sheets (Fig. 3, paragraphs [0021]-[0022], where there are multiple proof sheets being scanned).

Having a system of Kato '111 reference and then given the well-established teaching of Edwards '562 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of printing user-selected ones of a collection of images of Kato '111 to include scanning a plurality of user-marked proof sheets as taught by Edwards '562 because it would allow the method detect and scan multiple sheets improving the capabilities of the system to perform the proofing.

(2) regarding claim 9:

Kato '111 further discloses wherein at least some individual ones of the plurality of proof sheets are indicative of a same subset of the images (column 4, lines 56-67 and column 5, lines 1-4).

(3) regarding claim 40:

Kato '111 further discloses a method of printing subsets of images selected from a collection of images, comprising:

identifying the images in the collection (column 4, lines 53-67 and column 5, lines 1-4, where images are being selected from a collection in a digital camera);

printing at least one proof set (column 5, lines 1-4, where a proof sheets are being printed), each proof set including a proof sheet having a thumbnail representation of each image (column 5, lines 38-41, where the reduced image is being interpreted as a thumbnail image) and at least one user-markable field associated with at least one of the thumbnail representations (column 5, lines 40-41, where the check portion is the user-markable field);

distributing each proof set to a user, each user marking desired ones of the fields so as to define one of the subsets (column 5, lines 30-46, where the user makes the selection because the proof sheets where distributed);

retrieving the user-marked proof sets (column 6, lines 21-25, where after a user makes the desired selections the proof sheets are collected and processed);

optically scanning the proof sheet to detect the user-marked fields (column 6, lines 21-25, where Step S5 is performing the scanning of the proof sheet);

processing the user-marked fields to determine the images in the subsets (column 6, lines 26-33, where each proof sheet is checked for the markings in the sheet);

collating the subsets so as to determine, for each image, a corresponding number of copies to be printed according to a particular set of print characteristics (column 6, lines 34-45, where the selected number of copies determined by the user are read and used for printing); and

printing the corresponding number of copies of each image according to the corresponding particular set of print characteristics (column 6, lines 38-45).

Kato '111 discloses all the subject matter as described above except scanning a plurality of user-marked proof sheets.

However, Edwards '562 teaches scanning a plurality of user-marked proof sheets (Fig. 3, paragraphs [0021]-[0022], where there are multiple proof sheets being scanned).

Having a system of Kato '111 reference and then given the well-established teaching of Edwards '562 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of printing user-selected ones of a collection of images of Kato '111 to include scanning a plurality of user-marked proof sheets as taught by Edwards '562 because it would allow the method detect and scan multiple sheets improving the capabilities of the system to perform the proofing.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) and Edwards (US 2004/0174562) in view of Hicks (US 5,359,387).

(1) regarding claim 41:

Kato '111 and Edwards '562 disclose all the subject matter as described above except printing a summary sheet indicative of the images in each individual subset; and distributing the printed copies of the images to the users in accordance with the summary sheet.

However, Hicks '387 teaches printing a summary sheet indicative of the images in each individual subset (10 in Fig. 1 and column 4, lines 27-30); and

distributing the printed copies of the images to the users in accordance with the summary sheet (11 in Fig. 1 and column 4, lines 36-38).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made printing a summary sheet indicative of the images in each individual subset; and distributing the printed copies of the images to the users in accordance with the summary sheet as taught by Hicks '387 in the system of Kato '111 and Edwards '562. With this, it is possible to produce a plurality of negatives, a plurality of proof prints are made from the negatives on a single sheet of photographic proof paper, and an order form for ordering final photographic prints is printed on the single sheet of proof paper (column 2, lines 4-8).

6. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,141,111) and Edwards (US 2004/0174562) in view of Squilla et al. (US 6,623,528).

(1) regarding claim 42:

Kato '111 and Edwards '562 disclose all the subject matter as described above except wherein the printing comprises: rendering the image once to form a rendered image; and

printing the rendered image the corresponding number of times.

However, Squilla '528 teaches wherein the printing comprises: rendering the image once to form a rendered image (column 4, lines 59-64); and

printing the rendered image the corresponding number of times (column 4, lines 59-64).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the printing comprises: rendering the image once to form a rendered image; and printing the rendered image the corresponding number of times as taught by Squilla '528 in the system of Kato '111 and Edwards '562. With this consumers can create photocollages and photo albums in a manner that is as simple as ordering prints (column 1, lines 41-44).

Allowable Subject Matter

1. Claims 2-8 and 10-17 are allowed.
2. The following is an examiner's statement of reasons for allowance:

(1) Claim 10 is directed to a method of printing user-selected ones of a collection of images. Claim 10 identifies the uniquely distinct features of "determining identical ones of the print specifications; summing the print counts associated with all of the

identical ones to form a total print count T; and printing T copies of the selected image associated with the identical ones in accordance with the associated print characteristics". The closest prior art Kato (US 6,141,111) in Fig. 4A teaches at the prescribed positions of an extra-copy designation sheet 100, there are arranged a user ID input portion 101, a bin output selection portion 104, an E-mail deliver selection portion 105, an image index portion 102 and an extra-copy check portion 103. The bin output selection portion 104 and the E-mail delivery selection portion 105 are the portions to select the bin output to the bin 18 or the E-mail delivery to the image display 24 and other image printers 27 through 29 by way of the network 16. When such selection is desired, an operator himself writes a mark on the sheet. At this time, it is also possible to select both of them and if so, a mark is entered for both of the bin output and the E-mail delivery; either singularly or in combination with other cited references fails to anticipate or render the above underlined limitations obvious (when used with all the claimed limitations).

(2) Claim 2 is directed to a method of printing user-selected ones of a collection of images. Claim 2 identifies the uniquely distinct features of "wherein the processing includes determining a print count associated with each selected image, and wherein the printing includes: determining identical ones of the selected images; summing the print counts of the identical selected images to form a total print count T; and printing T copies of one of the identical selected images". The closest prior art Kato (US 6,141,111) in Fig. 4A teaches at the prescribed positions of an extra-copy designation sheet 100, there are arranged a user ID input portion 101, a bin output selection portion

104, an E-mail deliver selection portion 105, an image index portion 102 and an extra-copy check portion 103. The bin output selection portion 104 and the E-mail delivery selection portion 105 are the portions to select the bin output to the bin 18 or the E-mail delivery to the image display 24 and other image printers 27 through 29 by way of the network 16. When such selection is desired, an operator himself writes a mark on the sheet. At this time, it is also possible to select both of them and if so, a mark is entered for both of the bin output and the E-mail delivery; either singularly or in combination with other cited references fails to anticipate or render the above underlined limitations obvious (when used with all the claimed limitations).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Lennin R Rodriguez/
Examiner, Art Unit 2625